

### **REMARKS**

Applicants timely submit this response to the Examiner's Office Action of November 9, 2004, the period for response which has been extended one month to March 9, 2005. The Office Action has been carefully reviewed and the following remarks are made in response thereto.

Applicants also submit herewith an Interview Request Form. Applicants respectfully request the courtesy of a personal interview with the Examiner prior to the next action on the merits. Although Applicants have requested an interview in April, with a specific date to be arranged at a later date, Applicants are amenable to any later mutually acceptable date.

Additionally, although the Examiner asserts that "content provider requiring payment for information access" has not been given patentable weight because the phrase occurs in the preamble (*See*, Office Action, page 2, paragraph 3), the Examiner's interpretation of the claims and application of the cited references indicate that this phrase has indeed been treated as a claim limitation. (*See*, for example, paragraphs 13 and 14.)

In view of the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

#### **I. Summary of the Office Action**

1. Claims 1-23 are currently pending.
2. Claims 1-3, 14-20, and 23 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Van Der Meer.
3. Claims 4-13, 21 and 22 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Van Der Meer and further in view of Usui.
4. No claims were allowed.

## **II. Response to the Office Action**

### **1. Besette does not suggest the claimed invention.**

Each claim rejection presented in the Office Action of November 9, 2004 depends upon the alleged teachings of Besette. The Examiner relies on Besette for the proposition that it allegedly teaches an interactive computer system comprising three computers: a user computer, a “library system computer” (server 300) and a content provider computer (the NDSMR database). It does not. Specifically, the NDSMR database is not a content provider computer, but instead a database of files associated with the server 300 computer. Besette (US Patent No. 6,263,330 B1) is a method and apparatus for the management of data files. The NDSMR database stores these datafiles. As shown in Figure 3, which is attached hereto, the database is hardwired or an intrinsic component of the server 300 computer and not a separate content provider computer to which the server would ever establish a “telecommunication link.” The database is also not a content provider computer “requiring payment for information access...”. So, the rejections of the pending claims, each which rely on Besette, should be withdrawn, because Besette does not teach an interactive computer system comprising three computers. The Examiner has erroneously equated the database with a content provider computer with no basis for making that connection. That failing should end the analysis.

The flaw of the rejections presented in the November 9, 2004 Office Action stems from not viewing the teachings of Besette, the claimed subject matter and the differences between Besette and the claimed subject as a whole. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. (MPEP § 2141.01; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 200 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 460 U.S. 851 (1984)). Besette discloses devices and systems for managing files such as medical records. Medical records are stored in a database (NDSMR) that is a component of a server computer (server 300). User computers may access the records by accessing the server computer. Typically, the user requests a record from a server (server 300) managing the NDSMR database. The server then transfers the record that will be displayed on the user computer. At no point does the server computer establish a telecommunication link with

the NDSMR database. There simply is no need, because the database is a component of the server computer itself. A skilled artisan would have no motivation, there is no suggestion in Bessette, and the Examiner has provided no motivation to separate the database from the server computer and establish a telecommunications link between the two. Such a suggestion simply defies the teaching of Bessette, the state of the art in this field, and logic.

The Examiner recognizes that the NDSMR database and server computer (server 300) are not connected by a telecommunication link. Instead of viewing the teachings of Bessette as a whole (devices and systems for managing data files), he uses the claimed invention as the sole motivation to modify Bessette by connecting the server computer and NDSMR database through a telecommunication link. This is impermissible hindsight reconstruction. First, he relied on Angles, *et al.* for the general premise that computers could be connected through a telecommunication link. Because Angles, *et al.* taught a “one way” telecommunication link, the Examiner withdrew that reference and rejection and replaced it with Van Der Meer and a corresponding rejection. The Examiner relies on Van Der Meer for the same principle: computers may be connected through a telecommunication link. Any reason or suggestion why the specific components of the Bessette system would be connected by such means is absent from the analysis. The Examiner’s combination of either Angles, *et al.* or Van Der Meer with Bessette ignores the specific purpose and configuration of the system actually taught by Bessette.

The teachings of Bessette, when viewed as a whole, teach against the claimed interaction of library system where a fee is charged for access of a library system computer to a content provider computer. The NDSMR database of Bessette, which the Examiner incorrectly equates with the content provider computer, is a component of server 300. Furthermore, the data contained on the database is the property of the physicians accessing it from the user computers. There is no suggestion or motivation to require a charge for access to this information. Such an interpretation ignores the “whole” teaching of Bessette and is only motivated by the teachings of the pending application.

2. **Rejection of the claims under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Van Der Meer**

Claims 1-3, 14-20, and 23 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Van Der Meer. Applicants respectfully traverse this rejection.

Respectfully, the Examiner further fails to establish a *prima facie* case of obviousness for two reasons. First, the cited references, Bessette and Van Der Meer, neither teach nor suggest specific elements of the claimed methods or systems. Second, the Examiner fails to establish a suggestion or motivation to modify or combine the cited references by either: a) completely failing to identify reasons why a skilled artisan would modify or combine the teachings of the cited references to obtain the claimed invention; b) failing to consider the cited references as a whole; and c) improperly taking official notice.

**A. Each and every element of the claimed invention is not taught or suggested.**

The Examiner rejected the pending claims based on Bessette in the February 10, 2004 Office Action. In their August 10, 2004 Response, Applicants identified the deficiencies of this reference. Again, the Examiner rejects the pending claims as obvious over Bessette without acknowledging or addressing Applicants' arguments. Accordingly, Applicants respectfully submit that it would be improper and would prejudice Applicants if Examiner were to make the next Office Action final.

- **"...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer..."**

The claimed methods of claims 1-3 and 14-15 include the step of "...transmitting, by the library system computer, said type of information desired by the user as a search request to the content provider computer..." The Examiner does not address this element or Applicants' response to the first Office Action.

Applicants respectfully submit that the Examiner has not established a *prima facie* case. Accordingly, this rejection should be withdrawn and pending claims 1-3, 14 and 15 allowed.

- **“...customizing a user interface provided by the interactive library system to the user computer based on type of information desired by the user.”**

The method of claim 2 includes the step of “customizing a user interface provided by the interactive library system to the user computer based on type of information desired by the user.” The system of claim 19 includes “customized user interface data”.

The Examiner references a portion of Bessette (col. 7, lines 52-56) that states that a physician, after logging onto the server, may use an identifier to retrieve patient information. The referenced portion of Bessette does not teach “customizing a user interface provided by the interactive library system.” Instead, Bessette teaches accessing patient information stored on the NDSMR database. Bessette does not suggest that different users may alter or customize the interface, that the workstation provides interfaces specific to different users, or that the system could create and/or store “customized user interface data”. Thus, neither Bessette nor Van Der Meer teach or suggest a method including a step of “customizing a user interface” or a system including “customized user interface data”.

Applicants respectfully submit that the Examiner has not established a *prima facie* case. Accordingly, this rejection should be withdrawn and pending claims 2 and 19 allowed.

- **“...providing a user interface, by the interactive library system to the user computer that includes an interactive element, the selection of said element by the user activating a communication program to enable communication with a pre-selected contactee.”**

The system of claim 3 includes “providing a user interface, by the interactive library system to the user computer that includes an interactive element, the selection of

said element by the user activating a communication program to enable communication with a pre-selected contactee.” The Examiner does not address this claim, the claim element, or identify a reference that teaches this element and motivation to combine such a reference with Bessette and Van Der Meer.

Applicants respectfully request that this rejection be withdrawn and claim 3 allowed.

- **“...a library computer adapted to receive and transmit data over telecommunication links, said library computer having a microprocessor and a first storage unit...”**

The system of claim 16 includes “a library computer adapted to receive and transmit data over telecommunication links, said library computer having a microprocessor and a first storage unit.” Again, the Examiner does not address this claim element or Applicants’ response. The Examiner acknowledges that Bessette “does not teach establishing a telecommunications link with the content provider computer.” (*See*, Office Action, page 4, paragraph 7, lines 7-8). This deficiency is not cured by Van Der Meer.

Applicants respectfully request that this rejection be withdrawn and claim 16 be allowed.

- **“...a program operable on said microprocessor stored in said first storage unit, said program comparing user identification and password received from the user computer with said user identifications and corresponding passwords stored in said second storage unit to determine whether the user computer is authorized...”**

The system of claim 16 includes “a program operable on said microprocessor stored in said first storage unit, said program comparing user identification and password received from the user computer with said user identifications and corresponding passwords stored in said second storage unit to determine whether the user computer is authorized...”. The Examiner does not address this claim element or Applicants’ response to the first Office Action.

Applicants respectfully request that the rejection be withdrawn and claim 16 allowed.

- **“...said program, if the user computer is determined to be authorized, causing said library computer to communicate with content provider computer to transmit type of information desired by the user as a search request and to receive result of said search request.”**

The system of claim 16 includes “said program, if the user computer is determined to be authorized, causing said library computer to communicate with content provider computer to transmit type of information desired by the user as a search request and to receive result of said search request.” The Examiner does not address this claim element or Applicants’ response to the first Office Action.

Applicants respectfully request that the rejection be withdrawn and claim 16 allowed.

- **“...wherein said first and second storage units are the same.”**

The system of claim 17 includes the system of claim 16 “wherein said first and second storage units are the same.” The Examiner does not address this claim element or Applicants’ response to the first Office Action. Moreover, the Examiner’s application of Bessette and Van Der Meer effectively reads the “second storage unit” out of claim 17.

Applicants respectfully request that this rejection be withdrawn and claim 17 allowed.

- **“...a third storage unit electrically coupled to said library computer to store user-specific data.”**

The system of claim 18 includes “a third storage unit electrically coupled to said library computer to store user-specific data.” The Examiner does not address this claim element or Applicants’ response to the first Office Action. Accordingly, Applicants respectfully request that this rejection be withdrawn and claim 18 allowed.

- **“...wherein said user-specific data includes user account data.”**

The system of claim 20 includes “wherein said user-specific data includes user account data.” The Examiner does not address this claim element or Applicants’ response to the first Office Action.

Applicants respectfully request that this rejection be withdrawn and claim 20 allowed.

- **“...wherein said second and third storage units are the same.”**

The system of claim 23 includes “wherein said second and third storage units are the same.” The Examiner does not address this claim element. Accordingly, Applicants respectfully request that this rejection be withdrawn and claim 23 allowed.

**B. The Examiner’s reasoning constitutes improper hindsight reconstruction.**

With respect to claims 1-3, 14-20 and 23, the Examiner concedes that Bessette “does not teach establishing a telecommunication link” between the library system computer—designated “server 300” in Bessette—and “the content provider computer” (designated “NDSMR database” in Bessette). (*See*, Office Action, page 4, paragraph 7, lines 7-8). The Examiner concludes that “it would have been obvious to one of ordinary skill in the art to receive by the server of Besset [sic] an input from the user and establish the telecommunication link with the content provider computer (*i.e.*, Web server) as taught in Van Der Meer.” (Office Action, page 5, paragraph 9, lines 10-13). Applicants respectfully submit that there is no motivation to combine the teachings of Bessette and Van Der Meer to obtain the claimed invention and the Examiner’s reasoning represents improper hindsight reconstruction that is based solely on the Applicants’ disclosure.

In Figures 1, 17, and the abstract, on which the Examiner relies, Van Der Meer teaches a diary owner system, a diary server and content providers, each coupled to a computer network. The Examiner alleges that Van Der Meer discloses a method for transferring annotated universal address. (*See*, Office Action, page 4, paragraph 8, lines 9-10).



The Examiner does not consider the cited references as a whole. In determining the differences between the prior art and the claims at issue, the Examiner must consider both the invention and the references as a whole. MPEP §§ 2111- 2116.01; 2141.02. When determining the differences between the prior art and the claims, the operative question is not whether the differences themselves (a telecommunication link) would have been obvious, but whether the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Here, the Examiner simply grasps the general concept of a telecommunication link between computers organized into a very specific system as taught by Van Der Meer, and applies that concept to the interactive library system of the pending claims for the sole purpose of producing the claimed invention. This application of Van Der Meer focuses on the obviousness of the difference between the cited references and the claimed invention—not the obviousness or nonobviousness of the invention as a whole. This is impermissible hindsight reconstruction. (See, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143 and 2143.03).

Applicants respectfully request that this rejection be withdrawn and pending claims 1-3, 14-20 and 23 be allowed.

**C. Improper reliance on knowledge in the art.**

With respect to claims 14 and 15, the Examiner takes official notice of the state of the art and states “it is well known in the art to notify the user upon receiving the results of a search request by means of electronic communications.” (Office Action, page 7, paragraph 12, lines 5 – 6). Applicants respectfully disagree.

Under only very limited circumstances may an examiner take official notice of a fact not in the record or rely on “common knowledge” in the art to support a rejection. Official notice without documentary evidence to support an examiner’s conclusion should be taken only on the rare occasion when the noticed fact is capable of instant and unquestionable demonstration as being well known. (See, MPEP § 2144.03; see also, *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970)). That is not the case here.

The methods and systems of the claimed invention require “notifying, by the library system computer, the user computer that said result of said search request is ready for review by the user” and further, that the “notification is by electronic communication.” Broad notice that “receiving the results of a search request by means of electronic communications” is well known in the art does not take into account the specific methods of notification recited by the claims. Thus, the noticed fact is insufficient to support the Examiner’s rejection of the claims and the specific methods of notification recited by the claims are not the types of facts that are capable of instant and unquestionable demonstration as being well known. Furthermore, even if the Examiner were to produce a competent reference teaching the notification of a user upon receiving the results of a search request by means of elective communication, the Examiner provides no motivation to combine references, does not consider the claimed invention or prior art as a whole, and uses improper hindsight reconstruction.

Applicants respectfully request that this rejection be withdrawn and pending claims 14 and 15 be allowed.

3. **Rejection of the claims under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Van Der Meer and further in view of Usui.**

Claims 4-13, 21 and 22 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Bessette in view of Van Der Meer and further in view of Usui. Applicants respectfully traverse this rejection.

Respectfully, the Examiner fails to establish a *prima facie* case of obviousness for two reasons. First, the cited references, Bessette, Van Der Meer, and Usui, neither teach nor suggest the claimed methods or systems. Specifically, these references fail to teach or suggest specific elements of the claimed invention. Second, the Examiner fails to establish a suggestion or motivation to modify or combine the cited references by either: a) completely failing to identify reasons why a skilled artisan would modify or combine the teachings of the cited references to obtain the claimed invention; or b) failing to consider the cited references as a whole.

**A. Each and every element of the claimed invention is not taught or suggested.**

The Examiner concedes that “Besette [sic] and Van Der Meer do not teach determining the time amount of access, recording it and generating an account statement.” (Office Action, page 7, paragraph 14, lines 13-15). The Examiner then makes a blanket rejection of claims 4-13, 21 and 22 by alleging that “it would have been obvious to one of ordinary skill in the art to have the library system computer receiving the search results from the content provider of Besette and Van Der Meer and calculate access charges (*i.e.*, account statement) according to the amount of time used by each user as taught in Usui.” (Office Action, page 7, paragraph 14, lines 18 – 22). The Examiner, however, has failed to identify how Usui teaches any of the specific elements of claims 4-13, 21 and 22.

Applicants respectfully request that this rejection be withdrawn and pending claims 4-13, 21 and 22 be allowed.

**B. The Examiner’s reasoning constitutes improper hindsight reconstruction.**

Claims 4-13, 21 and 22 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Besette in view of Van Der Meer and further in view of Usui. Applicants respectfully traverse this rejection.

The deficiencies of Besette and Van Der Meer were previously detailed in Applicants’ Response to the February 10, 2004 Office Action. The Examiner has neither acknowledged nor addresses Applicants’ arguments with respect to Usui. Usui does not remedy the deficiencies of Besette and Van Der Meer. Consequently the Examiner fails to establish a case of *prima facie* obviousness of claims 4-13, 21 and 22.

Usui does not teach a “content provider requiring payment for information access.” In particular, Usui teaches a “timer-based fee-charging system for Internet services” for the purpose of eliminating the inconvenience of contracting with an Internet provider a providing “access to Internet connection services through an easy access and payment method.” (*See*, Usui, Abstract). Both the purpose and the nature of the system disclosed by Usui is to provide a fee-charging mechanism for “access to Internet

connection services”. Usui does not teach or suggest payment for “information access.” This is a fundamental difference between the claimed invention and Usui that highlights the Examiner’s hindsight reconstruction of this claimed invention.

The fee-charging system of Usui is limited to a timer-based system. The Examiner, however, applies the teachings of Usui to support the rejection of claims 10 and 11, which require the “library system computer” to determine “the number of search requests transmitted to the content providers for the user computer” and generate “an account statement” based on the number of search requests. Neither Bessette, Van Der Meer, nor Usui teach or suggest a search-based system for fee charging.

Applicants respectfully request that this rejection be withdrawn and pending claims 4-13, 21 and 22 be allowed.

### **III. Conclusion**

Applicants respectfully submit that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

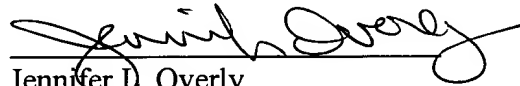
**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 02012.4101. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F. R. § 1.136(a)(3).

If the Examiner finds that a telephone conference would further prosecution of this application, the Examiner is invited to contact the undersigned at 202-835-7512.

Respectfully submitted,

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